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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) T7093.0016/P016 |
| | Application Number 09/879,917-Conf. #5556 | Filed June 14, 2001 |
| | First Named Inventor Stephen P. Forte | |
| | Art Unit 2618 | Examiner A. Perez |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"><div style="width: 45%;"><p><input type="checkbox"/> applicant /inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>41,198</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p></div><div style="width: 50%; text-align: center;"> _____ Signature Gianni Minutoli _____ Typed or printed name (202) 420-3191 _____ Telephone number April 30, 2007 _____ Date</div></div> | | |

☐ *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Stephen P. Forte

Application No.: 09/879,917

Confirmation No.: 5556

Filed: June 14, 2001

Art Unit: 2618

For: METHOD AND APPARATUS FOR
COMMUNICATING VIA VIRTUAL OFFICE
TELEPHONE EXTENSIONS

Examiner: A. Perez

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests a review of the legal and factual bases for the rejections in the above-identified patent application. Pursuant to the guidelines set forth in the Official Gazette Notice of July 12, 2005 for the Pre-Appeal Brief Conference Program, favorable reconsideration of the subject application is respectfully requested in view of the following.

The claimed invention relates to a system for selectively establishing communication with at least one wireless device associated with a telephone number serving as a virtual office extension. When the system receives an incoming call, it can route the call to a remote wireless device associated with a virtual extension, or to a combination of devices simultaneously, or as desired by the user. The system of virtual office telephones can be used to provide wireless devices the same level of service traditionally provided to hardwired telephones on a standard enterprise PBX network.

A. Withdrawal Of The Rejection Of Claims 1-3, 8, 10-13, 15-18 and 26 Is Warranted

According to the Final Rejection dated December 1, 2006, claims 1-3, 8, 10-13, 15-18 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier in view of Jackson and LaPierre.

THE CITED COMBINATION DOES NOT TEACH OR SUGGEST ALL LIMITATIONS

Hartmaier refers to a programming interface between applications that execute on a private data network and applications that execute in a proprietary wireless network (WIN). Hartmaier is essentially an interface communicating between two software programs. As mentioned in the Final Rejection, Hartmaier does not teach many of the claim 1 limitations including: “[a] telephony interface for receiving a telephone call via a first communication path, . . . identifying a dialed telephone number associated with the call, [and] using the dialed telephone number to retrieve . . . at least one user preference . . . to route the call to at least two wireless destination telephone numbers substantially simultaneously via a second or third communication path,” and “connecting the call to a user by connecting [the] first communication path to the second or third communication path when the second or third communication path is authenticated by the user.”

The Final Rejection, at page 3, attempts to to cure the above deficiencies by combining Hartmaier with Jackson and LaPierre. Applicant respectfully submits, however, that Jackson and LaPierre do not cure the deficiencies of Hartmaier. For example, claim 1 recites a “telephony interface [that connects] . . . the call to a user by connecting [the] first communication path to the second or third communication path when the second or third communication path is authenticated by the user.” The Final Rejection relies on Jackson as teaching this limitation. Jackson, however, fails to do so.

Jackson teaches a call routing system that sends a page request to a pager and a call request to a wireless phone in response to an inbound call. In Jackson, however, the incoming call is not forwarded to and cannot be answered by the user at the pager; instead, the pager only receives a page (via the request). Hence, Jackson cannot connect the incoming call to the pager’s communication path. The pager serves only as a notifying function that alerts the called party that he has a call at the wireless phone. Therefore, Jackson fails to teach a “telephony interface [that connects] . . . the call to a user by connecting [the] first communication path to the second or third communication path when the second or third communication path is authenticated by the user.” By contrast, Jackson teaches a system in which the user can answer the incoming call

using one communication path. In the claimed invention, the user can answer the incoming call using either the second or third communication path, which is connected to the first path.

Further, Jackson teaches a user pressing a call-connect key to connect the incoming call to the wireless device in response to an inaudible alert. Jackson Col. 3, ll. 55-58. This is not similar to the “authenticating” feature of claim 1. The claimed authenticating feature is different because the user authenticates the call by answering the respective wireless device associated with the communication path and pressing another key (or activating a feature at the device). In one aspect, if a user answers the wireless device associated with the second communication path, the second communication path is authenticated by the user and then the third communication path is terminated. This is different than Jackson and the other cited references. Accordingly, claim 1 and dependent claims 2, 3, 8, 10-13 and 15-18 are believed to be allowable.

Claim 26 recites a method comprising the steps of “providing at least one wireless telephone to the location; routing a telephone call made to an extension of the enterprise network via a first communication path to the wireless connect unit; [and] . . . routing the telephone call to at least one destination telephone number via a second communication path.” According to claim 26, “the wireless telephone can receive the call if the device associated with the second telephone number is unable to receive a call and the device associated with the second telephone number can receive the call if the wireless telephone is unable to receive the call.” For at least the reasons set forth above, Applicant respectfully submits that the cited combination fails to teach or suggest all limitations of claim 26.

THERE IS NO MOTIVATION TO COMBINE THE CITED REFERENCES

Applicant also respectfully submits that it would not have been obvious to combine the teachings of the cited prior art to achieve a system for selectively establishing communication with one or more of a plurality of wireless devices serving as a virtual office telephone. One of ordinary skill would not have looked to a programming interface between computer applications (Hartmaier) to combine it with a system for call routing/paging (Jackson) and a system for routing a call to an alternate destination associated with a universal number service (LaPierre) to achieve a system, serving as a virtual office, that establishes communication with one or more of

a plurality of wireless devices. Thus, Applicant respectfully submits that it is improper to combine the references in the manner suggested by the Final Rejection.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves. In re Fine, 837 F.2d 1071, 1084 (Fed. Cir. 1988). There is no suggestion or motivation in any of the references for combining them to arrive at the claimed invention. The Final Rejection is using impermissible hindsight by using the claims of the present application as a road map to improperly combine the references. Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. App. 1985); M.P.E.P. §2144. Accordingly, Applicant respectfully requests that the rejection be withdrawn and the claims allowed.

B. Withdrawal Of The Rejections Of Claims 4, 6, 7, 9 and 14 Is Warranted

Claims 4, 6, 7 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier in view of Jackson, LaPierre and Chow. Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier in view of Jackson, LaPierre and Cox.

Claims 4, 6, 7, 9 and 14 depend from claim 1. As such, they are each allowable over the Hartmaier, Jackson and LaPierre combination. Applicant respectfully submits for the reasons argued in its February 28, 2007 Response, the additional references do not cure the above-noted deficiencies of the Hartmaier, Jackson and LaPierre combination. Accordingly, the rejections should be withdrawn and the claims allowed.

D. Withdrawal Of The Rejections Of Claims 19-23, 24, 25 and 29 Is Warranted

Claims 19-23, 25 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier in view of Jackson, LaPierre and Karpus. Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartmaier, Jackson, LaPierre, Karpus and Chow.

Applicant submits that the Hartmaier, Jackson and LaPierre combination fails to teach “determining access rights for a user of the wireless telephone and if the user has rights to access the enterprise telecommunication network, generating and sending a simulated dial tone to the wireless telephone and providing access to [an] enterprise telecommunication network . . . that

consists solely of wireless devices,” as recited in claim 19. The systems in these references are simply too different. In addition, the Final Rejection admits that Hartmaier, Jackson and LaPierre do not teach or suggest claim 19’s act of generating a simulated dial tone, and relies on Karpus to solve only this shortcoming. Final Rejection at 12-13.

Karpus merely discloses an interface system that connects various devices to a radio telephone and provides arbitration between conflicting requests for access to the audio channel of the telephone. Karpus uses grant lines to communicate that access to the audio channel is available. Karpus is essentially an arbitration switch between devices and would not be used in combination with the systems of Hartmaier, Jackson and LaPierre and thus, Applicant believes Karpus to be not relevant to the technology of the claimed invention.

Even if relevant, Karpus does not teach or suggest “determining access rights for a user of the wireless telephone and if the user has rights to access the enterprise telecommunication network, generating and sending a simulated dial tone to the wireless telephone and providing access to [an] enterprise telecommunication network . . . that consists solely of wireless devices.” Claim 29 recites similar limitations, and thus these arguments equally apply to claim 29. Therefore, the cited combination fails to teach all of the limitations of claims 19 and 29. Claim 20-23 and 25 depend from claim 19 and are allowable along with claim 19.

Claim 24 depends from claim 19 and is allowable over Hartmaier, Jackson, LaPierre and Karpus for at least the reasons set forth above. Applicant respectfully submits that Chow does not overcome the shortcomings noted above for at least the reasons mentioned in the February 28th Response. Accordingly, the rejections should be withdrawn and the claims allowed.

Applicant also respectfully submits that it is improper to combine the 4th and 5th references in the manner suggested by the Final Rejection. As argued previously, Applicant respectfully submits that there is no motivation to combine the vastly different systems disclosed in Hartmaier in view of Jackson, LaPierre, Karpus and Chow. This is one more reason why the rejections of claims 19-23, 24, 25 and 29 should be withdrawn and the claims allowed.